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09/943,987	08/31/2001	Arthur D. Taylor	11653-002001	1363
26161	7590	10/20/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			WILKINS III, HARRY D	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/943,987
Filing Date: August 31, 2001
Appellant(s): TAYLOR, ARTHUR D.

John W. Freeman
For Appellant

EXAMINER'S ANSWER

MAILED
OCT 20 2004
GROUP 1700

This is in response to the appeal brief filed 09 July 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is substantially correct. The only deficiencies noted by the Examiner are that with reference to claims 5 and 9-12, the statement omits silver from the composition of the master alloy as can be seen in the copy of claim 5 in the appendix and that claim 7 is not directed to "a stamping, a wire or a sheet", but to "a jewelry casting, a stamping, a wire or a sheet" as can be seen in the copy of claim 7 in the appendix.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-6 with 8-12 as opposed to claim 7 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 5,384,089	Diamond	01-1995
US 2,223,046	Peterson	11-1940

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Diamond (US 5,384,089).

Diamond anticipates and/or obviates the claimed invention. Diamond teaches (see col 8, lines 21-34, claim 5) a gold alloy that contains 2.0-22.0 wt% Ag, 0.0-2.0 wt% Co, 2.0-47.33 wt% Cu and the balance Au (up to and including 22k (91.67 wt%)).

The ranges of Ag, Co and Cu disclosed by Diamond overlap the presently claimed ranges, thus anticipating those ranges. See MPEP 2131.03.

Alternatively, none of the examples disclosed by Diamond fall within the presently claimed range, however, it would have been within the expected skill of a routineer in the art to have selected values from within the broadly disclosed ranges of Diamond in order to optimize the functions of Ag, Co and Cu, particularly the silver for

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desired color and malleability (see Peterson at col. 4, lines 6-9), the cobalt for grain refinement (see Diamond at col. 4, lines 38-41) and the copper for desired color and hardness (see Peterson at col. 3, lines 65-69). Changes in temperature, concentrations, or other process conditions of an old process does not impart patentability unless the recited ranges are critical, i.e., they produce a new and unexpected result. In re Aller et al (CCPA 1955) 220 F2d 454, 105 USPQ 233. Only result-effective variables can be optimized. In re Antonie 559 F2d 618, 195 USPQ 6 (CCPA 1977). See MPEP 2144.05 II.

Regarding the presence of other elements in the composition of Diamond, the present claim recites a composition "comprising", which is defined as leaving the composition open to other elements, even in major amounts. See MPEP 2111.03.

Regarding the presence of B in the presently claimed composition, because the presence of B is optional, a reference need not teach its presence in order to anticipate and/or obviate the claim.

Regarding claim 2, Diamond teaches 2.0-22.0 wt% Ag, which overlaps the presently claimed range.

Regarding claims 3 and 4, Diamond teaches 0.0-2.0 wt% Co, which overlaps the presently claimed range.

Regarding claim 5, Diamond teaches (see col. 2, lines 24-25) that the alloy was made by making a master alloy and combining the master alloy with gold. By backing out the composition of Diamond by removing the gold, the composition of the required master alloy would have overlapped the presently claimed composition. Regarding the

presence of other elements in the composition of Diamond, the present claim recites a composition "comprising", which is defined as leaving the composition open to other elements, even in major amounts. See MPEP 2111.03. Regarding the presence of B in the presently claimed composition, because the presence of B is optional, a reference need not teach its presence in order to anticipate and/or obviate the claim.

Regarding claims 7 and 8, Diamond teaches (see abstract) that the gold alloys are useful in the casting of jewelry articles.

Regarding claims 6 and 9, Diamond teaches (see col. 2, lines 13-26) combining the master alloy with gold to make a 22k gold alloy.

Regarding claims 10-12, see above regarding claims 2-4.

(11) *Response to Argument*

Appellant has argued that:

- (1) The Diamond specification and claims disclose specific gold alloys having much lower gold content than the present 22k gold alloy.

In response, this is wrong. It can be clearly seen in Diamond from col. 2, lines 13-19 and claim 5, that the disclosure of Diamond teaches using the cobalt as a grain refiner for 8 to 22k gold alloys.

- (2) The Examiner picked and chose varying elements to create an example that meets all the present claim limitations but is not disclosed in Diamond.

In response, Appellant is reminded that the disclosure of the prior art should not be construed as being limited to only the specific examples disclosed therein. Since Diamond discloses a gold alloy at up to 22k, and uses 0-2 wt% Co, the "picking and

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“casting” of Ag and Cu are left to mere arithmetic in determining the composition counts due to there only being about 8 wt% left for these two elements after the Au is at 22k (91.67 wt%).

3) Claim 7 requires the alloy to be in the form of a stamping, wire or sheet and that this is not taught by Diamond.

In response, the Examiner directs Appellants to the copy of claim 7 in the appendix where it can be clearly seen that what claim 7 really requires is that the alloy is in the form of “a jewelry casting, a stamping, a wire or a sheet”. Diamond teaches making a jewelry casting from the alloy.

(4) Diamond contains no teaching whatsoever specifically addressing a 22k gold alloy.

In response, the disclosure at col. 2, lines 13-19 specifically addresses a 22k gold alloy, and it is covered by claim 5 [note that claims 1-4 of Diamond are directed to 10k, 18k, 14k and 8k and claim 5 to the broad composition, not 1-5 and 6 as referenced by Appellant on page 7]. Thus, Diamond does teach 22k gold alloys and in fact received patent coverage on them under claim 5. While it is apparent that the preferred composition of Diamond are 8-18k, Diamond should be taken as a whole, and not limited to only specific examples or preferred embodiments.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Harry D Wilkins, III
Examiner
Art Unit 1742

hdw
October 14, 2004

Conferees
Roy King
Robert Warden



ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

JOHN W. FREEMAN, ESQ.
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

APPEAL CONFERENCE: 